



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,118	11/19/2003	Kevin Krietemeyer	12406/79	9903

26646 7590 08/24/2005

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/718,118	Applicant(s) KRIETEMEYER, KEVIN	
	Examiner Kurt Fernstrom	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☒ Claim(s) 11 and 12 is/are allowed.
 6) ☒ Claim(s) 1,3-5,8-10,13,16,17,20,24-26 and 28 is/are rejected.
 7) ☒ Claim(s) 2,6,7,14,15,18,19,21-23 and 27 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 27 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 6, from which claim 27 depends, was amended to include all of the limitations of claim 27.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure in the specification that all of the games recited in claim 6 are simultaneously played.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8-10, 13, 16, 17, 20, 24 and 25 are rejected under 35

U.S.C. 102(b) as being anticipated by Jarvis. Jarvis discloses in Figures 1 and 2 and in column 2, line 24 to column 3, line 18 of the specification a method and device of playing a lottery comprising a gaming slip 12 comprising a substrate having gaming information printed thereon; including a random request region 26 that enables a plurality of computer-generated picks to be requested in conjunction with a lottery. Column 3, lines 3-17 in particular discusses the use of a computer to generate picks when a random request is received. With respect to claims 3 and 13, column 3, lines 3-17 further discusses the selection of six numbers when a random request is received. With respect to claims 4 and 8, Jarvis discloses that a manual selection region 14 including one or more manually selected numbers is provided which enables a manual pick to be made. With respect to claim 5, Jarvis discloses that a draw request region 22 is provided which enables picks to be played for a plurality of drawings. With respect to claims 17 and 20, a machine readable medium as claimed is inherent in the disclosure of Jarvis, in particular that portion which discusses the use of a computer to generate random numbers in response to a random request. It should also be noted that claim 17 recites a machine readable medium **to store** a set of instructions. By reciting the invention as an intended purpose, rather than a positive limitation, in strict

terms any computer readable medium reads on claim 17, and thus claims 18-20, as written.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvis. Jarvis discloses all of the limitations of the claim with the exception of the gaming slip being a piece of paper. Rather, Jarvis is silent as to the material used for the ticket. However, Official Notice is taken that paper is an extremely well known type of material to use for gaming slips, and would have been an obvious means to allow a user to request numbers which can then be fed into and processed by a computer.

Allowable Subject Matter

Claims 2, 6, 7, 14, 15, 18, 19, 21-23 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 11 and 12 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Essentially, the arguments presented by applicant with respect to the

Art Unit: 3714

combination of Jarvis with Mullins are persuasive. Jarvis and Mullins are directed to two very different types of gaming devices. There is no suggestion to combine the teachings to create the claimed invention, as Mullins does not provide any motivation to modify the teachings of Jarvis so as to read on the claims. As a result, the claims contain allowable subject matter. With respect to claims 21-23, the newly added language overcomes the prior art. Jarvis discloses a device where a player marks a plurality of boxes to request that number of computer-generated picks. There is no suggestion of a region which allows a player to select a number of picks by marking a single box corresponding to that number. This feature allows a user to conveniently select a larger number of picks to be generated by the computer.

Response to Arguments

Applicant's arguments filed on May 31, 2005 have been fully considered but they are not persuasive.

The amendment to claim 26 has not overcome the rejection under 35 USC 112. A review of paragraph 20 of the specification, as suggested by applicant, does not suggest that the subject matter was previously disclosed. It is not clear what language, specifically, describes the limitation of a plurality of games which are simultaneously played.

With respect to the rejections under Jarvis, the amendments to the claims do not overcome the reference. As noted previously, a "random request region" is a broad term, and can read on a plurality of individual boxes. Under this interpretation each

Art Unit: 3714

region still corresponds to a game, as all of the regions in Jarvis correspond to a game.


The language pertaining to different **types** of games does overcome the prior art, as discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KURT FERNSTROM
PRIMARY EXAMINER

KF
August 22, 2005